

38

wherein the output units generate the position and the orientation of a portion
of the nodes to the virtual objects.

39

REMARKS

Applicants have amended claim 94; claims 1-94 remain pending in the present reissue application.

The Examiner rejected claims 1-94 based on the recapture doctrine. In Applicants' previous response mailed January 6, 2000, Applicants argued that the only areas in which new claims 31-94 are broader than the original allowed claims 1-30 are areas that are not germane to surrendered subject matter. If this is true, then the recapture doctrine does not bar the claims.¹

Regarding the recapture doctrine, the Federal Circuit has stated that to determine whether an applicant surrendered particular subject matter, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.² In contrast to the Examiner's interpretation of Applicants' position, Applicants do not contend that **only** argued amendments are germane to prior art rejections. Applicants instead were merely highlighting that an applicant's arguments may be highly relevant in determining what is germane.³

The courts also look to the applicant's intent, and the court may draw inferences from changes in claim scope when other reliable evidence of the applicant's intent is not available.⁴ Deliberately canceling of amending a claim in an effort to overcome a

¹ See *In Re Clement*, 45 USPQ.2d 1161, 1165 (Fed. Cir. 1997).

² *Id.*

³ *Hester Indus. Inc. v. Stein Inc.*, 46 USPQ.2d 1641, 1647 (Fed. Cir. 1998) ("we look to the prosecution history for **arguments** and changes to the claims made in an effort to overcome a prior art rejection").

⁴ See *In Re Clement*, 45 USPQ.2d 1161, 1164 (Fed. Cir. 1997).

reference strongly suggests that the applicant admits that the scope of the claim before the cancellation of amendment is unpatentable, **but it is not dispositive because other evidence in the prosecution history may indicate the contrary.**⁵

Applicants contend that, after looking at the new claims and the prosecution history of the case, including the cite art, the claim amendments, and the argument, that it is clear that the new claims do not recapture subject matter Applicants intended to forfeit.

Furthermore, Applicants contend that the new claims are materially different from the claims in the original patent. As noted in *Chisum on Patents*, a patentee may obtain on reissue a claim that varies materially from the claim originally surrendered **even though it omits a limitation intentionally added to obtain issuance of the patent.**⁶ As Applicants noted in their previous response, new claims 31-96 recite additional features that render the new claims materially different from claims 1-30. For example, claim 36 recites “wherein the second set of data is received across a network,” and claim 37 recites “an Ethernet link, a phone link, and ISDN line, or a satellite link.” In contrast claims 1-30 fail to recite features related to networked utilization of the invention. Similarly, claim 44 also recites features not recited in the original claims such as “machines, articles of manufacture, animals, molecules...” Other examples include claim 68, which recites “one or more audio display devices configured to produce three-dimensional sounds...” and claim 69, which recites a number of different embodiments of the “body part sensing means”. Applicants further note that software claims such as claims 31-65, and 94, and kit claims such as claims 66-71 and 90-93 are materially different than the apparatus and method claims 1-30. Thus, for the reasons set forth above, Applicants reiterate that under *Ball*, *Clement*, and *Hester*, claims 31-89 are properly presented in this broadening reissue application.

Applicants must respectfully disagree with and traverse the Examiner’s assertion that “the final language of the allowed claim is the determinant of what is germane.”

⁵ See *In Re Clement*, 45 USPQ.2d 1161, 1164 (Fed. Cir. 1997).

⁶ See *Donald S. Chisum, Chisum on Patents* §15.03[2][e] (*emphasis added*).

Under this reasoning, there could never be a broadening reissue application on any amended claims because everything in the amended claims would have to be copied into the reissue claims. This defies the clear language of the case law from the Federal Circuit noted above. As the cases cited above indicate, there is an in-depth analysis that must take place, including looking at the cited art and the applicant's response. The Federal Circuit has stated that in a reissue case dealing with the recapture rule, the focus is not on the specific limitations or on the elements of the claims, but rather on the scope of the claims and the intent of the applicant.⁷

CONCLUSION

In light of the foregoing amendment and remarks, Applicants submits the application is now in condition for allowance, and an early notice to that effect is requested. If the Examiner does not find that the application is in a condition for allowance, Applicants respectfully request a telephone conference with the Examiner to discuss any remaining issues.

If any additional extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Conley, Rose, & Tayon, P.C. Deposit Account No. 03-2769/5181-10802/DRC.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Request for Approval of Drawing Changes
- ☐ Notice of Change of Address
- ☐ Check in the amount of \$302 for fees.
- ☐ Other: _____

⁷ See *Ball Corp. v. United States*, 221 USPQ 289, 296 (Fed. Cir. 1984).



Conley, Rose & Tayon, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 476-1400

Date: May 1, 2000

Respectfully submitted,

Dan R. Christen
Reg. No. 39,943
ATTORNEY FOR APPLICANT(S)

RECEIVED
MAY - 8 2000
TC 2700 MAIL ROOM